

## **REMARKS**

Claims 1, 4, 5, 7, 10, and 12-24 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Claims 1, 4, 5, 7, 10, and 12-24 stand rejected under 35 U.S.C. § 112, second paragraph for failing to point out and distinctly claim the invention. Claims 1, 4-5, 15-21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 5,018,060 to Gelb et al. (hereinafter Gelb) in view of United States Patent Number 5,757,571 to Basham et al. (hereinafter Basham) and in further view of United States Patent Publication 2003/0193994 by Stickler (hereinafter Stickler). Claims 7, 10, 12, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and Stickler and in further view of United States Patent Application Publication Number 2003/0204672 by Bergsten (hereinafter Bergsten). Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten and in further view of “Active Storage for Large-Scale Data Mining and Multimedia” Proceedings of the 24<sup>th</sup> VLDB Conference, New York, USA, 1998 by Erik Riedel et al. (hereinafter Riedel). Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten, and in further view of United States Patent Publication 2003/0120379 by Mehlberg et al. (hereinafter Mehlberg).

Applicants thank the Examiner for the telephone interview of October 29, 2007. Applicants presented two proposed exemplary amendments to claim 1 supported by the page 11, ¶ 38 of the specification. We agreed that the language of the second amendment was supported by the specification. Applicants agreed to submit that second proposed amendment and do so

with this response.

Response to rejections of claims under 35 U.S.C. § 112, first paragraph

Claims 1, 4, 5, 7, 10, and 12-24 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Applicants have amended claims 1, 7, and 15 to remove the limitation “...without scaling...” Claim 1 as amended. See also claims 7 and 15.

As amended, claims 1, 7, and 15 are directed to receiving a dataset with a storage instruction that does not direct that the dataset is stored with scaling, and selecting a scaling storage instruction in response to storage criteria. Applicants submit that as amended claims 1, 7, and 15 comply with the written description requirement, and that claims 4, 5, 10, 12-14, and 16-24 comply as depending from compliant claims.

Response to rejections of claims under 35 U.S.C. § 112, second paragraph

Claims 1, 4, 5, 7, 10, and 12-24 stand rejected under 35 U.S.C. § 112, second paragraph for failing to point out and distinctly claim the invention. As discussed above, Applicants have amended claims 1, 7, and 15 to be directed to receiving a dataset with a storage instruction that does not direct that the dataset is stored with scaling, and selecting a scaling storage instruction in response to storage criteria. Applicants submit that as amended, claims 1, 7, and 15 are allowable under 35 U.S.C. § 112, and that claims 4, 5, 10, 12-14, and 16-24 are allowable as depending from allowable claims.

### Amendments to the claims

Applicants have amended claims 1, 7, and 15 with the limitation “...with a storage instruction that does not direct that the dataset is stored with scaling...” The amendment is fully supported by the specification. See page 11, ¶ 38. Applicants have further removed “...without scaling exclusively...”

### Response to rejections of claims under 35 U.S.C. § 103(a)

Claims 1, 4, 5, 15-21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Stickler. Claims 7, 10, 12, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and Stickler and in further view of Bergsten. Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten and in further view of Riedel. Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten, and in further view of Mehlberg. Applicant respectfully traverses these rejections.

Claims 1, 7 and 15 as amended include the limitations “...receive a dataset for storage on a magnetic tape storage medium with a storage instruction that does not direct that the dataset is stored with scaling...” and “...select a scaling storage instruction...” Claim 1 as amended. See also claims 7 and 15. Thus the present invention claims selecting a scaling instruction for a dataset that was to be stored on magnetic tape with a storage instruction that does not direct that the dataset is stored with scaling.

Neither Gelb, Basham, nor Stickler discloses selecting a scaling instruction for a dataset that was to be stored with a storage instruction that does not direct that the dataset is stored with scaling. Applicants therefore submit that claims 1, 7, and 15 are allowable. Applicants further submit that claims 4, 5, 10, 12-14, and 16-24 are allowable as depending from allowable claims.

### Conclusion

As a result of the preceding amendments and remarks, Applicants submit that the application is in condition for prompt allowance. Should additional information be required regarding the traversal of the rejections of the claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

/Brian C. Kunzler/

Brian C. Kunzler  
Reg. No. 38,527  
Attorney for Applicant

Date: November 20, 2007  
8 East Broadway, Suite 600  
Salt Lake City, UT 84111  
Telephone (801) 994-4646  
Fax (801) 531-1929